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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,776	04/13/2006	Masahiro Yoshioka	0760-0353PUS1	3792
2292 7590 09/28/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER PAK, HANNAH J				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 09/28/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/575,776

Applicant(s)

YOSHIOKA ET AL.

Examiner

Hannah Pak

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicants' amendment/remarks filed on 07/29/2009.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 8-15, and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (Machine Translation of JP 2000-143985).

The rejection is adequately set forth in Pages 2-4 of Office action mailed on 04/29/2009 and is incorporated here by reference.

5. Claims 5-7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (Machine Translation of JP 2000-143985) as applied to claims 1-4, 8-15, and 19-25 above, and further in view of Hedaya et al. (US 4,208,492).

The rejection is adequately set forth in Pages 5-6 of Office action mailed on 04/29/2009 and is incorporated here by reference.

Response to Arguments

6. The applicants' arguments filed 07/29/2009 are fully considered but are not found persuasive. Specifically, the applicants argue that **(A)** their present invention exhibit advantageously improved properties with respect to high OD and high adhesiveness when compared to Comparative Examples 1 and 2 wherein Equations (3) and (4) fail to be satisfied (see Page 8 of the Applicants' Remarks) (see Pages 7-8 of the Applicant's Remarks). The applicants submitted "Nagase Declaration" for further support. The applicants also argue that Tsukamoto '985 fails to disclose or suggest a composition which is photo-curable as in the present invention. Tsukamoto '985 fails to disclose selecting an appropriate titanium nitride oxide component in order to satisfy Equations (3) and (4) for the black composition recited in the present claims. Tsukamoto '985 further fails to recognize the advantageously improved high OD and high adhesion properties achieved by the black composition of the present invention as evidenced by the comparative test results as evidenced by the Nagase Declaration. Thus, there are patentable distinctions between the present invention and Tsukamoto '985 (see Page 9 of the Applicants' Remarks). The applicants also argue that **(B)** Hedy '492 fails to disclose or suggest the required properties based on Equations (1)-(4). They also fail to make up for the deficiencies of Tsukamoto '985 and further fail to recognize the

unexpected advantageous properties achieved by the present invention (see Page 9 of the Applicants' Remarks).

With respect to argument **(A)**, Tsukamoto teaches employing polyimide resin or acrylic resin in the black coating composition with referred optical density (OD value) of 3.0 or more per 1 micrometer of film pressure (Paragraph 14), which overlaps with those claimed (not less than 4.4 per 1 micrometer). The applicants' arguments and data directed to alleged unexpected results do not overcome the prima facie case of obviousness established in the record. While it is true that a showing of unexpected results can rebut any inference of obviousness established by the prior art of record, the applicants have the burden of showing that the claimed invention as whole imparts such unexpected results. The applicants have not shown why the limited showing in the declaration is commensurate in scope with the degree of protection sought by the very broad claims of the instant application, *see MPEP § 716.02*. Accordingly, the applicants fail to rebut the prima facie case of obviousness established in the record.

Additionally, as indicated above, the x-ray intensity ratio R , I_1-I_3 , the optical values, disclosed by Tsukamoto et al. overlap with all the claimed values and ranges. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the invention was made, since it has been held that choosing the overlapping portion of the range taught by Tsukamoto et al., and the range claimed by the applicant, has been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

As to the photo-curable, this component is not recited in the claims, so the reference of Tsukamoto is not required to teach such component. Also, although Tsukamoto does not specifically mention photo-curable, Tsuakmoto does teach heat curing in its method on paragraph 22.

With respect to argument **(B)**, while Hedy et al. do not disclose all the features of the present invention, it is used as a teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention. Rather, this reference teaches a certain concept, and in combination with the other references discloses the presently claimed invention.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571) 270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hannah Pak
Examiner
Art Unit 1796

/HP/

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796

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